UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,109	03/16/2001	Kaoru Shimamura	1046.1248	8921

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EXAMINER
GARG, YOGESH C

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Office Action Summary	Application No.	Applicant(s)
		09/809,109	SHIMAMURA, KAORU
		Examiner	Art Unit
		Yogesh C. Garg	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 February 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20, 23 and 24* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20, 23 and 24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment received on 2/4/2005 is acknowledged and entered. The

applicant has amended claims 1-3, 7-9, 11-14, 16-20, 23, and 24 and canceled claims

21, 22, 25 and 26. Currently claims 1-20, and 23-24 are pending for examination.

Response to Arguments

2.1.   Applicant's arguments with respect to rejection of claims 12-19, under 35 USC

101 have been fully considered and are persuasive. The rejection of claims 12-19,

under 35 USC 101 has been withdrawn. As explained in his arguments and recited in

the preamble of independent claims 12 and 16 the claims are directed to a computer

readable medium having a program embedded (recorded) in it and executable by a

computer to perform a method, further recited in the body of claims.

2.2.   Applicant has not filed any substantive arguments in the amendment, filed

on 2/4/2005 with respect to rejection of claims 1-20, 23, and 24, under 35 USC 103 (a)

but has remarked that the reasons were discussed in a personal interview with the

earlier Examiner Gart on January 25, 2005 (who has since then left USPTO). In view of

the earlier Examiner leaving USPTO the application has been transferred to Examiner

Garg, the undersigned, for further examination. The examiner did not find any specific

reasons being mentioned in the EIN summary conducted on 1/25/2005 as why the prior

art of Leville et al., nor Ukai et al. either alone or in combination teaches or suggests all

the features of independent claims 1, 7, 11, 12, 16, 20, 23, and 24. However, the

examiner reviewed the applicant's earlier remarks filed on 6/7/2004 with respect to

rejection of independent claims 1, 7, 11, 12, 16, 20, 23, and 24 and found them

persuasive. Therefore, the rejection has been withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of Leville et al. in view of

Ying et al. (US Patent 6,853,980) and further in view of Gold et al. (US 2002/0032610

A1).

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112: ·

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 7-10 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Both the independent claims 7 and 16 recite

that the system is intended for purchasing goods which are a variety of font sets but the

body of the claims are directed to purchasing elements/characters which can stand

alone as separate goods different from the font sets. A preamble is generally not

accorded any patentable weight where it merely recites the purpose of a process or the

intended use of a structure, and where the body of the claim does not depend on the

preamble for completeness but, instead, the process steps or structural limitations are

able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and

Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In view of the

foregoing it is unclear if the invention is directed to font sets or some other elements and

have rendered the claims indefinite. Since claims 8-10 and 17-19 are dependencies of

claims 7 and 16 they also inherit the same deficiency.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1- 20 and 23-24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Leville et al., hereinafter referred to Leville, further in view of Ying et

al. (US Patent 6,853,980), hereinafter referred to Ying and further in view of Gold et al.

(US 2002/0032610 A1), hereinafter referred to Gold.

Regarding claim 1, Leville discloses a system for selling goods (a

merchandising system) through a computer network(Fig 1), where the goods are a

variety of elements which are different from each other and are sold one by one and

the system comprises a unit storage section host computer 10) storing a unit of the

variety of elements according to the number of elements and ranges to each of which

a unit is applied (page 7 lines 1821), as well as a detecting section(20) detecting the

number of elements to be purchased on the basis of information of one or more

elements to be purchased which is received from a purchaser(page 10, lines 8-9) and

a reading section(10) reading at least one unit corresponding to the elements to be purchased on the basis of the number of elements detected from the unit storage section(page 8 lines 25-27) and a calculating section (20) calculating the purchase price by using the read at least one unit price and the number of elements calculated(page 10 lines 8-9).

Leville does not disclose a system wherein the "goods" denotes a variety of font sets, wherein the font set comprises of elements, element being a character. However, Ying, in the same field of endeavor, that is selling goods on line teaches selling goods denoting a variety of font sets, wherein the font set comprises of elements, element being a character (see at least col.2, line 13-col.3, line 40, col.10, line 14-col.16, line 61). In view of Ying, it would have been obvious to one of an ordinary skilled in the art to modify the system of Leville to incorporate the features of Ying of selling goods denoting a variety of font sets, wherein the font set comprises of elements, element being a character because it will enable the users to sell and purchase fonts online and allow the users to vary the size of his letters to pack text more densely, using a variety of fonts to visually distinguish different parts of the text, for aesthetic use, art decoration, etc., as explicitly suggested in Ying (see at least col.1, line 59-col.2, line 11 and col.2, line 59-col.3, line 5).

Leville discloses a calculating section (20) calculating the purchase price by using the read at least one unit price and the number of elements calculated(page 10 lines 8-9) but combined with Ying does not teach storing plurality of units for each font set, each unit being a price per element corresponding to a range of elements to

which the font set is to be applied and fist calculating section calculating the number of

elements belonging to a range to which the read at least one unit is to be applied and

a second calculating section calculating the purchase price by using the read at least

one unit and the number of elements calculated. However, in the same filed of selling

and purchasing goods, Gold teaches storing plurality of units for elements, each unit

being a price per element corresponding to a range of elements to which the goods

being purchased is to be applied and fist calculating section calculating the number of

elements belonging to a range to which the read at least one unit is to be applied and

a second calculating section calculating the purchase price by using the read at least

one unit and the number of elements calculated (see at least Figs.1, 2, 3, 7, 9,

paragraphs 0010, 0033-0034, 0044-0046, 0053-0062 which describe that a pricing

can be generated via a graphical interface in real –time, applying different types of

stored business rules, such that conversion factors for different quantity breaks can be

used to calculate from stored units, where each unit represent a price per element,

that is if the purchase quantity increases the unit price per element falls to a lower

level and so on. Thus in order to calculate a final price first calculations are done to

determine the range in which the purchased quantity falls and after determining this a

second calculation is done using the corresponding unit price for that range to arrive at

the purchase price of the elements being purchased. In view of Gold, it would have

been obvious to one of an ordinary skilled in the art at the time of the applicant's

invention to have modified Leville/Ying to include the features of storing plurality of

units for elements, each unit being a price per element corresponding to a range of

elements to which the goods being purchased is to be applied and fist calculating

section calculating the number of elements belonging to a range to which the read at

least one unit is to be applied and a second calculating section calculating the

purchase price by using the read at least one unit and the number of elements

calculated. Doing so, as explicitly suggested in Gold (see at least paragraphs 0005-

0010) would allow the system in Leville/Ying to automate price management including

electronic publication of price tables with step down prices for higher quantities (see

Fig.7) as per the prescribed management policies to motivate buyers to purchase

large quantities of goods, that is elements of font sets.

Regarding claim 2, Leville/Ying/Gold teaches a system comprising a

purchase record storage section(see Leville-10) storing the number of elements

purchased in the past(page 7 lines 2122)(purchasing history) and an addition

section(see Leville 10) reading the number of elements purchased in the past from

the purchase record storage section where the number of elements is detected by

the detecting section and adding the read number to the detected number,

wherein the reading section reads at least one unit applied to the element to be

purchased from the unit storage section by using a result of addition by the

addition section(see Leville, page 7 lines 12-25) the computer(see Leville -10)

analysis adds the elements purchased in the past to the elements to be purchased

to determine the price to be offered.

Regarding claims 3 and 6, Leville/Ying/Gold discloses further comprising a

data storage section storing data sets and a creating section creating a supply file

including data corresponding to information of the elements to be purchased by

using the set of data stored in the storage section as well as a supplying section

supplying the created supply file to the purchaser and that the set of data

represents sentences divided every predetermined range, wherein the data

represents the range constructing sentences (see at least Ying col.2, line 21-col.3,

line 6 and col.30, line 30-col.31, line 4). In view of Ying, it would have been obvious

to one of an ordinary skilled in the art to modify the system of Leville to incorporate

the features of Ying of selling goods denoting a variety of font sets, wherein the font

set comprises of elements, element being a character, section storing data sets

and a creating section creating a supply file including data corresponding to

information of the elements to be purchased by using the set of data stored in the

storage section as well as a supplying section supplying the created supply file to

the purchaser and that the set of data represents sentences divided every

predetermined range, wherein the data represents the range constructing

sentences because it will enable the users to sell and purchase fonts online and

allow the users to vary the size of his letters to pack text more densely, using a

variety of fonts to visually distinguish different parts of the text, for aesthetic use, art

decoration, etc., as explicitly suggested in Ying (see at least col.1, line 59-col.2, line

11 and col.2, line 59-col.3, line 5).

Regarding claim 4, Leville/Ying/Gold teaches a system wherein the receiving section(see Leville,10) receives a supply file further including information on past purchases by the purchaser.

Regarding claim 5, the limitation that the set of data is a font set data and that a piece of the data is font data as an element of the font set data is already covered in claim 1 analyzed above.

Regarding claims 7-20 and 23-24, their limitations are closely parallel to the limitations covered in claims 1-6 above except for the limitations of a transmitting section transmitting information of one or more elements to be purchased to a seller, a receiving section receiving a price of the element to be purchased which is calculated by using at least one unit of an element determined on the basis of the number of elements to be purchased and a range to which the unit is applied and a display controlling section for displaying the received prices. Leville discloses all these limitations: a transmitting section(17) transmitting information of one or more elements to be purchased to a seller and a receiving section(170 receiving a price of the element to be purchased which is calculated by using at least one unit of an element determined on the basis of the number of elements to be purchased and a range to which the unit is applied and a display controlling section(17) displaying the received price onto a display. Therefore, claims 7-20 and 23-24 are also rejected as being unpatentable over Leville/Ying/Gold as analyzed as above.

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

(i) US Patent 6,882,344 to Hayes et al. (see at least col.8, line 41-col.10, line 34)

and US Patent 5,646,992 (see at least col.1, line 30-col.5, line 34 and Figs.1-27)

discloses/suggests a method and system for purchasing a variety of font sets online

using a client-server architecture via a communication network.

(ii) US Publication 2001/0047312 to Verchere discloses a method and system for

storing a plurality of unit prices per element corresponding to a range of elements,

detecting the number of elements to be purchased, reading at least one unit price

corresponding to the elements to be purchased, first calculating the number of elements

belonging to a range to which the read at least one unit is to be applied and a second

calculation for calculating the purchase price by using the read at least one unit and the

number of elements being purchased (see at least fig.4, 6a, , 8,10a, 12a, paragraphs

0039-0049).

(iii) Article, " Bitstream releases its first set of fonts from the …………Designers

Holly Goldsmith and John Denver"; Business/Technology Editors; Business Wire; New

York; Sep 19, 2000; extracted from Proquest Database on 6/20/2005 discloses

websites selling fonts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
June 21, 2005